

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN KUSTERMANN and HANS-PETER SOLLINGER

Appeal No. 96-3192
Application No. 08/247,672¹

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 13 through 15, as amended subsequent to the final

¹ Application for patent filed May 23, 1994. According to the appellants, the application is a division of Application No. 07/631,375, filed December 20, 1990, which was a continuation-in-part of Application No. 07/385,212, filed July 25, 1989.

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rejection. These claims constitute all of the claims pending
in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a device for coating a running web. An understanding of the invention can be derived from a reading of exemplary claim 13, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Warner 1956	2,729,192	Jan. 3,
Kuhnel 1963	3,088,842	May 7,
Brezinski 24, 1965	3,202,536	Aug.
Sollinger et al. 1989 (Sollinger)	4,848,268	July 18,

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Brezinski, Sollinger and Warner.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Brezinski, Sollinger and Warner, and further in view of Kuhnel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed April 16, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed March 18, 1996) and reply brief (Paper No. 17, filed June 17, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 13 through 15 under

35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the modifications necessary to arrive at the claimed invention. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive

at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With this as background, we turn to the rejection of claim 13, the only independent claim on appeal.

Claim 13 recites the embodiment of the present invention shown in Figure 2 wherein only two rolls are utilized. Specifically claim 13 recites

A device for coating a running web, comprising:

a rotatable roll having a rubberized surface for the support of the web during a first coating process;

first applicator means for applying to the surface of the rotatable roll during the first coating process a small dosed quantity of a first coating substance, said first applicator means including a nozzle chamber having a discharge end near the rotatable roll surface through which said first coating substance is passed, said first applicator means further including at said discharge end a rotary doctor and a holder for said rotary doctor, said rotary doctor having closely adjacent fine peripheral grooves or helical grooves, said first coating substance having a solid or pigment substance content between 50% and 70%;

a backing roll, said backing roll configured and juxtaposed with respect to said rotatable roll such that a press gap for pressing at least a thin layer of said dosed quantity of said first coating substance on the web is formed between the backing roll and the rotatable

roll, **said backing roll providing support for the web during a second coating process;** and

second applicator means for applying a layer of a second coating substance directly on said web **during said second coating process**, said layer of second coating substance being applied in direct succession to the layer of first coating substance one upon the other while the layer of first coating substance is still moist, said second applicator means including a nozzle chamber having a discharge end near the web to be coated through which the second coating substance is passed, said second applicator means further including a rotary doctor and a holder for said rotary doctor of said second applicator means, said rotary doctor and holder arranged at said second applicator means discharge end. [Emphasis ours].

After reviewing the examiner's determinations of obviousness (answer, pp. 5 and 7-8), it is our conclusion that even if the applied prior art were combined in the manner set forth by the examiner it would not have resulted in the modifications necessary to arrive at the claimed invention. In that regard, the claimed invention requires the backing roll to (1) form a press gap with the rotatable roll for pressing at least a thin layer of the first coating substance on the web, and

(2) provide support for the web during the second coating process. The examiner's determinations of obviousness would have (1) replaced Brezinski's first coating system (i.e., coater 33 and backup roll 32) with a press gap coating system as taught by Sollinger, and (2) replaced Brezinski's second coating system (i.e., trough 35 and coating roller 34) with a coating system as taught by Warner. However, these modifications would not have resulted, absent impermissible hindsight, in the backing roll used in the press gap of the first coating system providing support for the web during the second coating process. In addition, it appears to us that the prior art applied to claim 13 would not have suggested that the claimed "rubberized surface" on the rotatable roll which applies the first coating substance to the web in a press gap. While roll 30 of Warner has a covering 31 of rubber, roll 30 is a support/backup roll, not a roll which applies the coating to the web.

Since all the limitations of independent claim 13 are not taught or suggested by the applied prior art, the decision of

the examiner to reject independent claim 13, and claims 14-15²
dependent thereon, under 35 U.S.C. § 103 is reversed.

² We have also reviewed the Kuhnel reference additionally applied in the rejection of claim 15 (dependent on claim 14) but find nothing therein which makes up for the deficiencies of the prior art applied to claim 13 as discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13 through 15 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JEFFREY V. NASE)	
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GJH

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APPLICATION NO. 08/247,672

APJ NASE

APJ FRANKFORT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 10 Nov 98

FINAL TYPED: